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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,637	05/04/2001	Dov Malonek	20066.79	6911

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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT PAPER NUMBER

3762

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/849,637	Applicant(s) MALONEK ET AL.	
	Examiner George R. Evanisko	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-33, 36-48, 50-61 and 63-85 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 41-44, 45/(19 and 41-44) and 74-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5-18, 20-33, 26-40, 45 (5-18, 20-33, 36-40), 46-48, 50-61, 63-73.

DETAILED ACTION

Election/Restrictions

Claims 46-48 and 50-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/26/03.

Claims 5-18, 20-33, 36-40, 45/(5-18, 20-33, 36-40), and 63-73 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made by election by original presentation in the office action dated 12/10/04 and **without** traverse in the reply filed on 6/10/05.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 76, 77, 81, and 82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter which was not in the original disclosure was the diameter of the lead being smaller than 2.5 mm or 2 mm (claims 76 and 77). The original specification stated the diameter was smaller than 1.5 mm and 1.2 mm (pages 18 and 27 of the specification).

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In addition, the specification did not disclose the unitary/signal electrode being longer than 15 mm and shorter than 30 mm (claims 81 and 82). The original specification used a range of 10-40 mm or 5-40 mm (pages 20 and 27) which is different than the new 15-30 mm range now being claimed. This rejection is related to new matter.

Claims 19, 41-44, 45/(19 and 41-44) and 74-85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The subject matter not disclosed is how to make a unitary/signal electrode having a capacitance greater than 300 microfarads and less than 3000 microfarads, in combination with the other elements in the claim. The specification lists several materials used for the electrode (page 8), such as platinum iridium, briefly states that porous materials increase the capacitance and minimize impedance (page 22), and discloses that a capacitance of 300-3000 microfarads is used (page 20). But, the specification is silent as to how the electrode is made to have a 300-3000 microfarad capacitance. Several questions arise as to how to make the electrode have a capacitance of 300-3000 microfarads, such as: How is the porousness changed? Is it increased or decreased for the unitary/signal electrode? How is the porousness changed for each of the different electrode materials? How does it affect the capacitance? How does the length, electrode material, thickness of electrode material, etc. affect the capacitance (and in combination with the porousness)?

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In addition, one skilled in the art could not practice/make the invention without undue experimentation to arrive at an electrode with a capacitance of 300-3000 microfarads. Several factors have been considered to arrive at this conclusion, such as:

The amount of direction provided by the applicant is minimal. Several common/conventional electrode materials are listed in the specification (page 8), but only a brief mention is made that porous materials increase the capacitance (page 22).

As stated above, several questions arise as to how to make the electrode and therefore undue experimentation would be necessary.

The applicant has provided no working examples in the specification.

The state of the prior art is silent as to how to make an electrode with a capacitance of 300-3000 microfarads (and using porousness and/or the specific electrode materials). The examiner has provided a recent patent (Ekwall) showing the use of electrode thickness, not porousness, to change the capacitance, but the capacitance is only changed to 1-15 microfarads. In addition, the applicant argues on page 16 of the reply dated 6/10/05 that the same materials used by applicant (titanium nitride, iridium oxide) at most have a capacitance of 150 microfarads, and therefore more guidance on how to make the electrode is needed.

Finally, the claims are very broad (a common electrode and connector) and only really have a limitation directed to the electrode having a 300-3000 microfarad capacitance. Therefore, more guidance than "porous materials increases the capacitance" is needed.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Evanisko whose telephone number is 571 272 4945. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571 272 4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


George R Evanisko
Primary Examiner
Art Unit 3762

7/21/05

GRE
July 24, 2005